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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,880	09/09/2003	Jon B. Telleen	JBT-1	2628
34491	7590	08/04/2004	EXAMINER	
JAMES K. POOLE, ESQ. P.O. BOX 925 LOVELAND, CO 80539			GEHMAN, BRYON P	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,880

Applicant(s)

TELLEEN, JON B.

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 22-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 and 30-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/2/04 06/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election with traverse of Group I in the paper filed June 28, 2004 is acknowledged. The traversal is on the ground(s) that the claimed method begins when the hotels distribute the holder assemblies to the hotel guests. This is not found persuasive because the claimed method of use includes selling advertising and printing the advertising onto the holder assembly, which does not involve the hotel guests and does not further limit the structure of the holder assembly per se.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it contains legal phraseology in lines 2, 3 and 7(twice), i.e. "access means" and "identification means". Also in line 5, "or the like" is considered indefinite legal phraseology and should be replaced. Correction is required. See MPEP § 608.01(b).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-21 and 30-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 3, "said space" should be --the space--, as "said" should be limited to elements of the claimed invention. A space, for example, is outside the scope of the structure actually being claimed. Similarly, in lines 5-6, "said access means" is outside the scope of the claimed structure and should be --the access means--. In line 5, "the user" lacks antecedent basis.

In claim 2, line 3, "and/or" is indefinitely alternative.

In claim 3, line 1, "said space" is again improper and should be --the space--. See also claims 13, 14, 18 and 34.

In claim 6, "said access means" is again improper and should be --the access means--. See also claims 7, 8(twice), 9 and 16-17.

In claim 8, line 3, "said envelope" is inconsistent with claim 7, "at least one envelope".

In claim 10, line 2, "said pouch" is inconsistent with claim 9, "at least one pouch".

In claim 13, lines 1-2, "said space identification portion" is inconsistent with claim 1, "identification portion". A single terminology should be employed throughout the claims. See also claims 14-16. Also in claim 13, line 2, "said holder" lacks antecedent basis except as an adjective. See also claim 14.

In claim 20, line 1, device is misspelled.

In claim 30, line 5, "the guest" lacks antecedent basis. In line 6, "said room number portion" lacks antecedent basis. In line 6, "to keep same" is indefinite as to what antecedent is intended to be encompassed.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 11-13, 17-18, 20-21 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Laughlin (5,529,172). Claims 1-3, 12 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Nish et al. (4,305,267). Each discloses a holder assembly for an access means (22; 18; respectively) comprising a security device (6; 10) comprising an identification portion (17; 50) and further comprising one incentive (use of the coupon; exchanging of the key periodically, see col. 3, line 44 through col. 4, line 21) motivating a user to separate the identification portion from the access means (22; 18).

As to claims 2 and 12, each discloses the access means as a mechanical key.

As to claim 3, each discloses the space as being a hotel room.

As to claims 4-6, Laughlin discloses two panels (6, 17) of sheet material, printed matter (a coupon) and a pocket or slot (4).

As to claim 7, the strip (10) of Laughlin serves as an envelope.

As to claim 11, Laughlin discloses a magnetic key card (12).

As to claim 13, Laughlin discloses perforations (16) to separate the identification portion.

As to claims 17-18 and 21, Laughlin's holder assembly and security device will not allow use of the key or card unless removed from the holder assembly and security device.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin in view of Hollar Jr. (1,667,258). Hollar Jr. discloses an envelope or pouch (1) for securing a key prior to employment. To modify Laughlin employing the envelope or pouch teaching of Hollar Jr. would have been obvious in order to secure from tampering with the key prior to its use.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin in view of Thompson et al. (6,520,542). Thompson et al. discloses a peelable portion (16) (Figure 16) separable to separate and also reveal information. To modify Laughlin employing the peelable portion teaching of Thompson et al. would have

been obvious in order to separate and reveal information by the separation, as suggested by Thompson et al..

11. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin in view of Jacobs et al. (4,488,737). Laughlin has been explained above. Jacobs et al. disclose the desirability of keeping an access means separate from a room number for security reasons (see col. 1, lines 15-26). To provide instructions to do so as part of the information indicia of Laughlin would have been obvious in view of Jacobs et al. in order to keep the access means unidentifiable if lost.

12. This application contains claims directed to the following patentably distinct species of the claimed invention: I) Figures 1 and 2; II) Figures 3-4 and 5A; III) Figures 3-4 and 5B; IV) Figures 3-4 and 5C; V) Figures 6-7; VI) Figures 8A-8B; VII) Figures 8C-8D; VIII) Figure 9; IX) Figure 10A; X) Figure 10B; XI) Figure 10C; XII) Figures 11A-11B; XIII) Figures 11C-11D; XIV) Figures 11E-11F; XV) Figure 11G; XVI) Figures 12A-12D; XVII) Figures 13A-13B; XVIII) Figures 13C-13D; XIX) Figures 13E-13F; XX) Figures 14A-14B; XXI) Figures 15A-15B; XXII) Figure 15C; XXIII) Figure 16A-16C; XXIV) Figure 17; XXV) Figure 18; XXVI) Figures 19A-19B; XXVII) Figures 20A-20B; XXVIII) Figures 21A-21B; XXIX) Figures 22A-22B; XXX) Figure 22C; and XXXI) Figures 23A-23B.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is held as generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

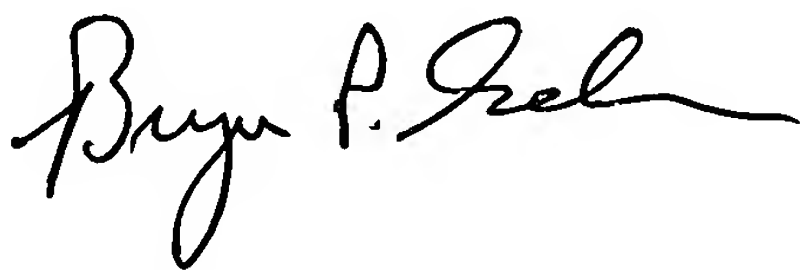
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wright discloses a key holder assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (703)

605-1174. The examiner can normally be reached on Monday through Wednesday from 5:30am to 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BPG

Bryon P. Gehman
Primary Examiner
Art Unit 3728